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IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1978
No. 78-1304

AMERICAN SEATING COMPANY,
Petitioner,

v.

NATIONAL SEATING COMPANY,
Respondent,

REPLY BRIEF IN PETITION OF WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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REPLY BRIEF IN PETITION OF WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

I. SIGNIFICANT DIFFERENCES BETWEEN THE STRUCTURES DEFINED BY THE CLAIMS IN THE '226 PATENT AND THE PRIOR ART CHAIRS WERE RECOGNIZED BY THE SIXTH CIRCUIT AND SHOULD HAVE NEGATED THE HOLDING OF ANTICIPATION.

Of utmost importance in this case is the significant difference between the bus chair defined by the claims in the '226 patent and the round base chairs relied upon by the Court for anticipation. Respondent denies such differences and states in its brief at page 4 that the Sixth Circuit found that the only difference between these chairs was the shape of their feet, i.e., round versus tubular. In referring to this statement of the Sixth Circuit, the respondent ignores the Sixth Circuit characterization of the difference as being a "significant difference" (A 25). Further, this significant difference is evident by a prefunctory comparison of the round base pedestal and the tubular inverted "T" prior art pedestals (A 40).

The very substance of the Sixth Circuit's error with relation to its holding under Section 102 was to ignore these "significant differences" between the round base pedestals and the tubular inverted "T" pedestal which was the very difference between success and failure as evidenced by the fact that the '226 seats with tubular inverted "T" pedestals replaced the aisle leg seats whereas the round base seats did not and in fact were discarded.

II. THE CHANGE OF FORM FROM A ROUND PLATE TO A TUBULAR INVERTED "T" PEDESTAL REQUIRES A DETERMINATION OF WHETHER SUCH CHANGE WAS OBVIOUS UNDER SECTION 103.

Respondent argues on page 7 of its brief that American's mere change of form from a round plate for a foot to a well known rectangular tube for a foot, does not avoid the application of the anticipation test of Section 102 to support a holding of invalidity. In making this argument, respondent relies upon *National Connector Corp.* v. *Malco Mfg. Co.*, 392 F.2d 766, 770 (8th Cir. 1968). A review of that case establishes that the Eighth Circuit did not hold the patent in question invalid because of anticipation but considered the question of obviousness under Section 103 when it stated at page 769:

> "The basic issue, assuming novelty and utility established, concerns 'obviousness' under section 103."

Therefore, the *National Connector* decision supports Petitioner's contention that the Sixth Circuit erred in holding the patent invalid under Section 102. Having found the pedestals were significantly different in shape, it should have then considered only the question of "obviousness" under Section 103. To do otherwise, equates the test under Section 102 to the test under Section 103.

III. THE DECISION IN *NICKOLA* IS NOT CONSISTENT WITH THE OPINION IN THIS CASE.

Respondent argues that *Nickola* v. *Peterson*, 580 F.2d 898 (6th Cir. 1978) is consistent with the opinion in this case because in its finding one of the elements of the claimed combination was not present in the best single prior art structure. However, in the present case all of the elements in the claimed combination are likewise not present in the best

single prior art structure, i.e., the specific foot defined in the claims of '226 patent is not present in the round base pedestal seat structures relied upon by the Sixth Circuit. Therefore, the Sixth Circuit holding of anticipation in this present case is not consistent with the *Nickola* decision.

Respondent attempts to draw an analogy between *Nickola* and the present case by reciting *Monroe Auto Equipment* v. *Heckethorn Mfg. & Sup. Co.*, 332 F.2d 406 (6th Cir. 1964), cert. den. 379 U.S. 888 (1964), for the proposition that the proper test for anticipation is "substantial identity." However, a review of the *Monroe* case establishes that the claimed combination of a "non-metallic spacer sleeve between a shock absorber and a coil spring" were also present in the prior public use device (p. 415). In the *Monroe* case the claims read on the prior art device resulting in anticipation under the Section 102 test. The '226 patent claims cannot possibly be read on the prior round base seats.

IV. IN FINDING THE '226 PATENT CLAIMS OBVIOUS, THE SIXTH CIRCUIT EXPRESSLY DID NOT CONSIDER THE MOST PERTINENT EVIDENCE ON UNOBVIOUSNESS.

Respondent in its brief alludes to some of the evidence which establishes that Edwards, a man held to be skilled in the art, did have available all the prior art relied upon by the Court to invalidate the patent. Despite such knowledge and its abortive efforts to conceive and develop, Edwards was unable to develop a successful single pedestal seat until long after Petitioner had the '226 invention on the market. Therefore, he did not make "a known choice to meet known requirements" as contended by Respondent. To the contrary, Edwards discarded prior art, including the round base seats, upon which the Court relied and eventually adopted the identical foot of the seat of the '226 invention. What better evidence could there be of the actual unobviousness of the invention to an actual person skilled in the art.

All of the facts alluded to by Respondent as to the activities of National, Heywood-Wakefield, American, and Howell, before and approximately at the time that the '226 invention was conceived, is evidence of the prior art available to Edwards during his abortive attempts to come up with a satisfactory and successful single pedestal seat. Barecki, the inventor of the '226 patent broke through these barriers with his unobvious combination and Edwards finally followed suit nearly two years later.

By stating on page 622 (A 29) of its decision that "The District Court, in resolving the obviousness issue, did not make findings with respect to American's contentions. . ." it is clear that the Courts did not consider all of the evidence surrounding the actual attempts of an actual person skilled in the art to design a successful single pedestal seat which is a primary consideration in determining what was obvious or unobvious to one skilled in the art. In their failure to consider such evidence, the District and Appellate Courts committed grave error.

V. PETITIONER'S REASONS FOR GRANTING CERTIORARI BASED ON THE "SYNERGISM" ISSUE FALLS SQUARELY UNDER RULE 19.

Respondent argues that Petitioner's contention that it was unnecessary for the Court to consider whether the claimed combination produced a synergistic effect did not raise any Rule 19 reason for granting certiorari. Such argument has no basis particularly in view of a recent circuit court decision on the issue of whether synergism is an essential requirement for patentability.

In the Seventh Circuit decision of *Republic Industries, Inc.* v. *Schlage Lock Co.*, [not yet reported but included in Petitioner's Expanded Appendix], the Court, after a careful reading of the Supreme Court's rulings in *Anderson's-Black Rock Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273 (1976), was

convinced that synergism—while perhaps an analytical tool of dubious value—is *not* a requirement for patentability. The Court stated (A 66):

> Neither *Sakraida* nor *Black Rock* can be cited as prescribing some other, special test for the evaluation of combination claims. Nowhere in these two decisions did the Court hold a synergistic effect to be a necessary condition of patentability; nor did it hold that synergism supersedes a finding of nonobviousness under the *Graham* analysis. To the contrary, each case cited *Graham* with approval. Each turned on whether the claimed invention was nonobvious on the basis of the three-pronged test in *Graham*. In short, we believe that *Sakraida* and *Black Rock*, rather than establishing an additional, different, or substituted test for nonobviousness under section 103, reaffirmed the continuing vitality of *Graham*.

Judge Swygert, in what he referred to as a "realistic appraisal," held (A 67) that synergism is "only a figure of speech." He continued that in many inventions (especially those that are mechanical rather than chemical) it is nonsense to speak of an element "functioning differently in combination than it did outside the combination," or to insist that the combination produce an effect "greater than the sum of the several parts taken separately." He pointed out that a spring or valve "will always function as a spring or valve, alone or in concert with other elements," and that "the overall performance of the combination is always equal to the sum of the functions of its individual components." The Court makes the very point at A 67, 68 that is being made in this petition. Specifically:

> . . .when using the synergism approach to determine whether one element functions differently or whether the whole somehow exceeds the parts one is required to look solely to the operation of the

elements *after* they are combined. This analysis suffers from two defects. First, the test which looks exclusively to the functioning of the individual components after they are combined must necessarily be premised on the assumption that it is always obvious to take known elements and combine them. We find this assumption unsound and not based on fact. It may be that in certain circumstances the very choice of the elements to be selected is not obvious.

* * *

The second and more basic defect with synergism is that section 103 sets as the standard of patentability the nonobviousness of the invention "at the time the invention was made to a person having ordinary skill in the art. . . ." This provision therefore compels the courts to view the invention from the vantage point of the field of art at a specific point in time, i.e., the time the invention was made. See Rich Principles of Patentability, 28 Geo. Wash. L. Rev. 393, 405-06 (1960). From this vantage point the critical question becomes whether the level of skill in the art was such that the combining of the elements in the manner claimed would have been obvious, not in retrospect, but at the time it was done by the inventor.

* * *

Synergism, however, precludes this analysis. Because synergism centers exclusively on the performance of the elements *after* combination and without regard to the obviousness or nonobviousness of *making the combination*, synergism does not comport with the *Graham* mandate to apply section 103.

The Court is urged to adopt this well reasoned approach to the determination of the obviousness-nonobviousness issue.

It is obvious the "synergism" issue falls squarely under Rule 19 in view of two other very recent decisions of the Eighth Circuit, *Reinke Mfg. Co.* v. *Sidney Mfg. Corp.*, [not yet reported but see A 70], and the Tenth Circuit, *Deere & Co.* v. *Hesston Corp.* [not yet reported but see A 89]. In both of these decisions the Courts held that one factor to look at in determining whether the patents meet Section 103 requirements is synergism. Thus, a situation exists in which within the Sixth Circuit two recent cases disagree as to whether "synergism" is a requirement and the Seventh, Eighth, and Tenth Circuits disagree. Accordingly, the issue of "synergism" falls squarely within the context of Rule 19.

CONCLUSION

In conclusion it is submitted that the issues as raised by this Petition should be reviewed by the United States Supreme Court in order to establish an orderly and logical approach which the lower courts can follow and which is so badly needed for the guidance of the patent law profession. Therefore, it is respectfully solicited that this Petition be granted.

Respectfully submitted,

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